

Docket Number: 10006447-1
Application No. 09/995,900
Response C

REMARKS/ARGUMENTS

Claims 9 – 17, 21, and 24 – 26 are in the application. Reconsideration is respectfully requested.

Rejections under Section 102 (35 USC § 102(b))

Independent claims 9 and 16 were rejected as anticipated by Jackson, US Patent No. 5,934,140.

Claim 9 recites, in part, a print drive mechanism that is configured to advance print medium. Claim 9 also recites a shim that is biased against the print medium drive mechanism.

In one embodiment, the print drive medium is a drive roller 92 against which the shim 126 is biased. Fig. 3 of the present application illustrates this arrangement during the time in which a piece of print media is compressed between the drive roller and shim for accurate thickness measurement as noted in paragraph 42 of the application.

The office action identifies in Jackson some print medium drive mechanisms (rollers, gates and conveyors). The component identified in the office action as a shim 112, however, is not biased against any of those drive mechanisms as is recited in claim 9. Rather, Jackson provides a much different system where, for example, two shim-like members are biased against each other, and not against a drive mechanism.

Accordingly, Jackson fails to disclose the combination of elements defined in claim 9.

The MPEP makes it clear that “to anticipate a claim, the reference must teach every element of the claim.” (MPEP § 2131) Quoting Federal Circuit Court opinions, the MPEP continues:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In view of the foregoing explanation of how Jackson fails to disclose at least one element of claim 9, the rejection of that claim, and the claims depending therefrom, should be withdrawn.

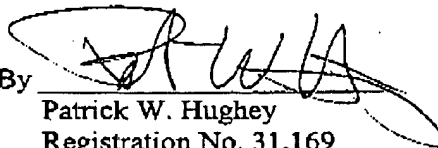
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Claim 17 is a method claim that is closely analogous to apparatus claim 9. Applicant submits that for the reasons set forth above with respect to claim 9, the rejections of claim 17 should also be withdrawn.

Conclusion

In view of the foregoing, applicant believes that all of the currently pending claims are in condition for allowance, and an early notification to that effect is respectfully requested. If the Examiner has any questions, he is invited to contact applicant's attorney at the below-listed telephone number.

Respectfully submitted,
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